

Appl. No. 09/718,604
Amtd. Dated 5/18/2005
Response to Office action dated 03/24/2005

REMARKS

Claims 1-37 are pending. No new matter has been added.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Claims 1, 12, 20 and 28 have been amended, notwithstanding the belief that these claims were allowable. Except as specifically admitted below, no claim elements have been narrowed. Rather, cosmetic amendments have been made to the claims and to broaden them in view of the cited art. Claims 1, 12, 20 and 28 have been amended solely for the purpose of expediting the patent application process, and the amendments were not necessary for patentability.

Any reference herein to "the invention" is intended to refer to the specific claim or claims being addressed herein. The claims of this Application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this Application, except for arguments specifically directed to the claim.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 1-37 under 35 USC § 103 as obvious from Nishio et al. (USP 6,381,651) in view of Schmid et al. (USP 6,438,578). This rejection is respectfully traversed.

"To establish a *prima facie* case of obviousness, [...] the prior art reference (or references when combined) must teach or suggest all the claim limitations." *MPEP 706.02(f)*.

Claims 1, 12, 20 and 28:

Claim 1 recites among other features, "while the web browser displays the first web page, the client outputting a message to the output device which informs the unregistered user of the availability of the first recommendation, without referring to a user profile of any kind." The Examiner asserted that Schmid teaches "to cause the network client to request supplemental

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information', col. 6, lines 42-43, but never registration information" and "the supplemental information to the network client as having originated with the requested information source', col. 7, lines 14-16 which will result from initial request, however the initial request may have been technically 'registered', but the user did not register." Schmid, at 6:42-43 and 7:14-16, does not include the feature "but never registration information" or "but the user did not register." Schmid, like Nishio, requires a user profile, whether entered by the user or created based on the user's history file, in order to provide a recommendation (see Schmid 7:27-54 and 8:40-63). Because neither Nishio nor Schmid teach "while the web browser displays the first web page, the client outputting a message to the output device which informs the unregistered user of the availability of the first recommendation, without referring to a user profile of any kind," claim 1 is patentable over Nishio in view of Schmid.

To the extent that claims 12, 20 and 28 have features similar to claim 1, the arguments set forth for claim 1 are applicable to claims 12, 20, and 28. Therefore, claims 1, 12, 20, and 28 are in form for allowance. It is respectfully requested that the rejection be withdrawn.

Claims 2-11, 13-19, 21-27 and 29-37:

By virtue of their respective dependence from claims 1, 12, 20 and 28, claims 2-11, 13-19, 21-27 and 29-37 are patentable over Nishio in view of Schmid. It is respectfully requested that the rejection be withdrawn.

Conclusion

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

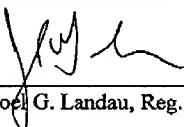
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In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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